

REMARKS

An Office Action was mailed on December 15, 2003, and declared final. Applicant filed a Request for Reconsideration on January 23, 2004. An Advisory Action was then issued on February 13, 2004. Claims 1-5 are pending.

In this response, claim 1 has been amended. Claims 6-8 have been added. No claims have been deleted. Consequently, claims 1-8 are under consideration. Support for the amendments to the claims can be found at least in Figure 5 of the drawings. Therefore, no new matter has been added. Amendment of a claim is not to be construed as a dedication to the public of any subject matter.

Claims 1 and 3-5 stand rejected under 35 USC §102(b) as being anticipated by Slot Machines A Pictorial Review - 1973 Bally "Circus" (referred to below as "Bally"). The Examiner alleges that Bally discloses a mechanical slot machine having a circus theme and that it additionally discloses:-

- the display means displays a plurality of spinning reels (see Figure),
- each reel carrying symbols from a set of symbols (see Figure),
- one of the symbols (monkey symbol) of the set of symbols on the reels of a gaming machine is a scatter symbol (see Figure and p.119),
- in respect to at least one of the reels, the set comprising a plurality of the scatter symbols (monkey symbols), at least certain of the scatter symbols on said at least one reel being separated from each other on the reel by at most one symbol, so that when more than a minimum number of scatter symbols are displayed simultaneously at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols (see Figure and p.119).

The Examiner further indicates that *Bally discloses "an unusual play feature..... the monkey special, which pays 20 coins for three monkeys in any position in the reel glass". Therefore, the monkey special could be three monkeys displayed on the same reel, two monkeys on one reel (adjacent or separated by one symbol) and another monkey displayed on any one of the two remaining reels, etc.*

With respect, the Examiner is misunderstanding the meaning of the term "scatter" symbols. Scatter symbols need not occur on an active payline in order to constitute a winning combination. An active payline is one which has been bought by a player so that, when a winning combination of symbols occurs on that payline, the player wins a prize. Conversely, if the winning combination of symbols occurs on an inactive payline, i.e. one that has not been bought by the player, the player will not win any prize even though the combination of symbols constitutes a prize winning combination.

This not the case where scatter symbols are concerned. For example, using the illustration of Bally, it is to be noted that there are three symbol positions on each of the three reels displayed in the window at any one time. However, it is to be noted further that there is only a single payline applicable being the line extending through the central position of each of the reels.

In order for a player to win a prize, the prize winning combinations of standard symbols, for example, the cherry symbols must occur on that payline.

In respect of the monkey symbol, this need not be the case. In other words, in respect of the first reel, the monkey symbol could appear in the first, top, visible position or the third, bottom, visible position and similarly with respect to reels two and three. Thus, even though the monkey symbols do not appear on the payline, provided that there are three monkey symbols appearing anywhere in the window, the mere fact that they are in a visible position on the display constitutes a winning outcome. It is therefore in this context in which the passage "in any position" has been used in the passage quoted by the Examiner in the present Office Action.

In the Advisory Action dated February 13, 2004, the Examiner indicated that he respectfully disagreed with Applicant's interpretation of the phrase "in any position" as it relates to Bally. The Examiner was of the view that, as broadly interpreted, the language does not preclude the reference from reading on the claims.

For the reasons set forth above, it is respectfully submitted that the Examiner is incorrect in his interpretation. A person of ordinary skill in the art will readily appreciate that what is being referred to in Bally is the interpretation of "in any position" as provided by the Applicant. This is the standard scatter symbol arrangement applicable to spinning reel games where the

scatter symbols can occur in any position on each of the reels, not only on the payline or active paylines of multi-line gaming machines.

This is, in fact, borne out by the remaining part of the paragraph to which the Examiner refers where it is specified that "[t]his feature offers a player twenty-seven possible winning combinations" (Applicant's emphasis).

There are twenty seven possible winning combinations because there are three reels and three visible display positions of each reel in Bally and, most importantly, only one monkey symbol is visible in any one reel at any one time. If one were to place the Examiner's interpretation on Bally and it were possible for there to be more than one monkey symbol visible on any one of the reels at any one time that would allow for more than 27 winning combinations.

Consider the situation where two monkey symbols were carried on the first reel and separated by one symbol position. In such a case there would be thirty six possible winning combinations being the 27 where only one monkey symbol is visible on each reel plus the additional nine combinations for the four monkey symbols being displayed. Thus, with all due respect, the Examiner's interpretation of Bally is incorrect. Bally quite clearly contemplates only one monkey symbol being able to be displayed on any one reel at any one time and does not teach that it is possible for there to be more than monkey symbol visible at the same time on any of the reels.

The Applicant therefore respectfully requests reconsideration and withdrawal of the 35 U.S.C. §102(b) rejections since it is well established that, in respect of a novelty objection, the prior art must disclose all the elements of the invention as claimed. ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaul Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

Further, because Bally does not teach that: *the positions of at least certain of the scatter symbols on said at least one reel being separated from each other on the reel by no more than*

one other symbol position so that, when more than one scatter symbol of the at least one reel are displayed simultaneously with scatter symbols occurring on any of the other reels at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols, anticipation of the present invention is necessarily negated. This is because all the elements of the claimed invention are not disclosed in a single reference. A similar consideration applies in respect of each of new claims 6-8.

For the reasons previously given, it is respectfully submitted that the invention as claimed in claim 1, the claims depending from claim 1, and claim 6-8 are inventive over Bally since what is claimed is, in fact, a new style of paying combinations. The idea of having a potential winning payout of more symbols than there are reels or columns, which is possible with the present invention, is not taught or suggested by Bally. The availability of numerous special symbols occurring in visible positions on each of the reels facilitates completely different payouts and winning combinations in contrast to the teachings of Bally. It is respectfully submitted that one of ordinary skill in the art would not have reference to the teachings of Bally as it does not render obvious the invention as claimed in the claimed combination - "*The Gillette Co v S. C. Johnson & Son Inc.*, 16 U.S.P.Q. 2d 1923, 1927 (Fed. Cir.). Thus, the present invention as claimed is, respectfully, patentable over the prior art of record.

Applicant has fully responded to each matter of substance raised in the Office Action and believes that the case is in condition for allowance. Withdrawal of the rejections and allowance of the application is therefore courteously solicited. Should the Examiner have any requests, questions or suggestions, the Examiner is invited to contact Applicant's attorney at the number listed below.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,

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